

Docket No.: HIENER.1CPC1CP

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Please Direct All Correspondence to Customer Number **20995**

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF TRANSMITTAL**

Applicant : Bogdan C. Maglich  
App. No : 09/883,851  
Filed : June 18, 2001  
For : METHOD AND APPARATUS FOR  
NEUTRON MICROSCOPY WITH  
STOICHIOMETRIC IMAGING  
Examiner : Daniel L. Greene Jr.  
Art Unit : 3663

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence and all  
marked attachments are being deposited with  
the United States Postal Service as first-class  
mail in an envelope addressed to:  
Commissioner for Patents, P.O. Box 1450,  
Alexandria, VA 22313-1450, on

December 12, 2006

(Date)

Bruce S. Itchkawitz, Reg. No. 47,677

**Mail Stop Appeal Brief-Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing in the above-identified application are the following enclosures:

- (X) Response to Notice of Non-Compliant Appeal Brief in 6 pages.  
(X) Declaration of Bruce S. Itchkawitz, Ph.D.

The fee has been calculated as shown below:

FEE CALCULATION				
FEE TYPE		FEE CODE	CALCULATION	TOTAL
5 Month Extension				\$1,080
			<b>TOTAL FEE DUE</b>	<b>\$1,080</b>

- (X) An extension of time is hereby requested by payment of the appropriate fee indicated above.  
(X) A check in the amount of \$1,080 is enclosed.  
(X) Return prepaid postcard.

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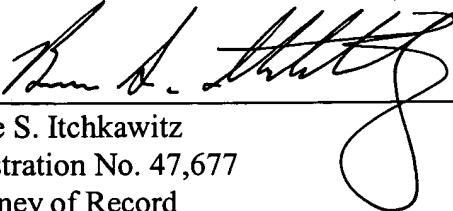
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App. No.: 09/788,736

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

  
Bruce S. Itchkawitz  
Registration No. 47,677  
Attorney of Record  
Customer No. 20,995  
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REINER.1CPC1CP

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Bogdan C. Maglich	Group Art Unit 3663
Appl. No.	:	09/883,851	
Filed	:	June 18, 2001	
For	:	METHOD AND APPARATUS FOR NEUTRON MICROSCOPY WITH STOICHIOMETRIC IMAGING	
Examiner	:	Daniel L. Greene Jr.	

**RESPONSE TO JUNE 12, 2006 NOTICE OF NON-COMPLIANT APPEAL BRIEF**

**Mail Stop Appeal Brief-Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This communication is responsive to the Notice of Non-Compliant Appeal Brief mailed on June 12, 2006 ("the Notice"). In the Notice, the Examiner, Daniel L. Greene Jr., and Supervisory Patent Examiner, Jack Keith, indicate that the Appeal Brief filed on March 10, 2006 is defective for failure to comply with one or more provisions of 37 C.F.R. § 41.37. For the reasons discussed below, Applicant submits that the Appeal Brief as filed on March 10, 2006 is fully compliant with 37 C.F.R. § 41.37 and that the Notice was improperly issued. In addition, Applicant submits that the communication which is the basis for the Notice and for requiring Applicant to provide additional information is an improperly-filed protest which must not be entered into the record for consideration by the Examiner. Applicant respectfully requests that the Notice and the requirement for additional information from Applicant be withdrawn, that the communication not be entered for consideration by the Examiner, that the original protest papers be sent to Applicant, and that the appeal be allowed to proceed.

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**Filed** : **June 18, 2001**

**Appeal Brief is Fully Compliant with 37 C.F.R. § 41.37**

Pursuant to M.P.E.P. § 1205.03 (Rev. 3, August 2005), “the examiner will review the brief to ensure that the required items of the brief are present” and “[b]oth the Board and the examiner will review the brief for compliance with the content requirements of the brief.” As stated in the Notice, the Examiner has performed such a review and has determined that the items required by 37 C.F.R. § 41.37 are present in the Appeal Brief. At page 2, lines 1-2 of the Notice, the Examiner states that (emphasis added) “The Appeal Brief appears to be compliant, however based on newly received information (attached hereto), applicant is being given the opportunity to review and respond.” Nowhere does the Examiner cite any deficiency of the Appeal Brief under the requirements outlined by 37 C.F.R. § 41.37. Unless the Examiner or the Board identifies one or more such deficiencies, Applicant submits that the Appeal Brief filed March 10, 2006 is fully compliant with the requirements under 37 C.F.R. § 41.37. Therefore, Applicant respectfully requests that the Notice be withdrawn and the appeal be allowed to proceed.

**Notice Based on Improper Grounds**

Applicant submits that issuance of the Notice is based on improper grounds. Pursuant to M.P.E.P. § 1205.03, as cited above, the Examiner is empowered to review the appeal brief to ensure that “the required items of the brief are present” and that the brief is in “compliance with the content requirements of the brief.” However, instead of an apparent deficiency of the Appeal Brief, the basis articulated by the Examiner at page 2, line 2 of the Notice is that “based on newly received information (attached hereto), applicant is being given the opportunity to review and respond.” Because this reasoning does not identify a deficiency in the Appeal Brief warranting the issuance of the Notice pursuant to M.P.E.P. § 1205.03, Applicant submits that the issuance of the Notice is improper. Therefore, Applicant respectfully requests that Notice be withdrawn and the appeal be allowed to proceed.

**Communication Received by Examiner Does Not Satisfy the Requirements of a Petition**

In the Notice, the Examiner states that “a protest based upon this application has been filed under 37 CFR 1.291 on May 09, 2006, and a copy is attached hereto entitled ‘STATEMENT REGARDING INTERACTIONS WITH BODGAN MAGLICH.’” However, Applicant submits that for numerous reasons described below, this communication referred to by the Examiner does not satisfy the requirements of a protest under 37 C.F.R. § 1.291, so it must

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not be entered into the record of the present application for consideration by the Examiner, and cannot be used to require Applicant to supply additional information.

Communication not served upon the applicant in accordance with 37 C.F.R. § 1.291

Pursuant to 37 C.F.R. § 1.291(b), a communication will be entered into the record of the application as a protest if “the protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.” Under 37 C.F.R. § 1.248(a), “service of papers must be on the attorney or agent of the party if there be such.” A protestor should make every effort to serve a copy of the protest upon the attorney of record, pursuant to M.P.E.P. § 1901.03.

Applicant is submitting herewith a “Declaration by Bruce S. Itchkawitz, Ph.D.” in which Dr. Itchkawitz, attorney of record for the assignee of the present application, declares that no such communication has been served on him or his firm. In addition, the communication does not include any proof of service as required by 37 C.F.R. § 1.248(b) for papers which are required to be served. Furthermore, the communication contains no indication, as required by M.P.E.P. § 1901.03, that (i) service was made upon Applicant’s attorney of record; or (ii) service was not possible and the communication was filed with the Office in duplicate. Therefore, the communication has not been served upon Applicant in accordance with 37 C.F.R. § 1.248, so the communication must not be entered into the record of the present application for consideration by the Examiner and cannot be the basis for requiring Applicant to provide additional information.

Communication not filed in a timely manner in accordance with 37 C.F.R. § 1.291

Under 35 U.S.C. § 122(c), the U.S. Patent and Trademark Office has established procedures “to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.” Pursuant to 37 C.F.R. § 1.291(b), a communication will be entered into the record of the application as a protest if “except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published under § 1.211, or a notice of allowance under § 1.311 was mailed, whichever occurs first.” Under 37 C.F.R. § 1.291(b)(1), “[i]f a protest is accompanied by the written consent of the applicant, the protest will be considered.”

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Applicant submits that the present application was published under 37 C.F.R. § 1.211 on September 4, 2003 as U.S. Patent Application Publication No. 2003/0165213. Therefore, the communication filed on May 9, 2006 was not filed prior to the publication date of the present application. Furthermore, the communication was not accompanied by the written consent of the applicant, and in the “Declaration by Bruce S. Itchkawitz, Ph.D.,” Dr. Itchkawitz explains that such consent is not given by Applicant. Therefore, the communication does not satisfy the requirements of 37 C.F.R. § 1.291(b) for being timely filed and must not be entered into the record of the present application for consideration by the Examiner and cannot be the basis for requiring Applicant to provide additional information.

Communication does not contain information required by M.P.E.P. § 1901.03

Pursuant to M.P.E.P. § 1901.03, a protest under 37 C.F.R. § 1.291 must “specifically identify the application to which the protest is directed by application number or serial number and filing date.” Furthermore, pursuant to M.P.E.P. § 1901.03, “[p]rotests which do not adequately identify a pending patent application will be returned to the protestor or discarded, and will not be further considered by the Office.” Nowhere does the communication include such mandatory information.

Based on the insufficient information provided by the communication, it is not clear how the communication was directed to the present application by the U.S. Patent Office. The only identifying information included in the communication appears to be the name of the inventor, Bogdan Maglich. However, Applicant submits that this information is insufficient to identify the application to which the protest is directed. At the time the communication was received, there were seven pending U.S. patent applications listing Bogdan Maglich as the sole inventor, including the present application, each of which has different claim sets directed to different inventions. The communication does not contain any information helpful in determining which invention is being addressed by the communication. It merely refers generally to “his invention” and “his patent disclosure.” Applicant submits that by merely identifying “Bogdan Maglich,” it is unknown to which invention the communication is to be directed.

The Examiner appears to also be confused regarding which application is being addressed by the communication. The identical communication was similarly improperly used by the Examiner to issue a Notice of Non-Compliant Appeal Brief with regard to U.S. Patent

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Application No. 09/788,736, which is co-pending with, but has different claims than, the present application.

Because the communication does not provide the mandatory information required by a protest, Applicant submits that the communication must not be entered into the record of the present application for consideration by the Examiner. In addition, the communication cannot be the basis for requiring Applicant to provide additional information.

**Actions of the Examiner required by M.P.E.P. § 1901.06(V)**

Pursuant to M.P.E.P. § 1901.06(V)(A), because the communication was submitted as a protest after the publication of the present application, the communication “should not be entered in the application file.” In addition, the Examiner should notify Applicant that “the protest is untimely and that it is not being entered in the application file.” Therefore, Applicant respectfully requests that the Examiner state that the communication is untimely and confirm that the communication is not being entered in the application file.

Furthermore, pursuant to M.P.E.P. § 1901.06(V)(A)(2), where the protest does not include an indication of service, as in the present case, “the duplicate copy of the protest (if present) should be discarded and the original protest papers should be sent to the applicant along with the notification of nonentry” (emphasis added). Applicant respectfully requests that the Examiner send to Applicant the original protest papers, including the communication and any transmittal sheets, envelopes, or other papers which accompanied the communication received by the U.S.P.T.O., as required by M.P.E.P. § 1901.06(V)(A)(2).

**Communication signed by a patent agent who is presumably aware of the above requirements**

Applicant notes that one of the signatories of the communication is “Dr. Laura Tunnell,” who is a registered patent agent (Registration No. 45,166). Applicant submits that as a registered patent agent, Dr. Tunnell is presumably aware of the requirements for protests under 37 C.F.R. § 1.291 and M.P.E.P. § 1900 et seq., as discussed above. Dr. Tunnell is presumably also aware of (i) the prohibition pursuant to 37 C.F.R. § 1.291(d) against unauthorized *ex parte* communications between the Examiner (and other U.S.P.T.O. personnel) and persons other than the applicant in the pending application; and (ii) the prohibition pursuant to 37 C.F.R. § 1.291 and M.P.E.P. § 1901.06(III) against a protestor’s completion of an incomplete protest or further participation in, or inquiry to the status of any Office proceeding relating to the initial protest. Applicant respectfully requests that the Examiner be careful to not engage in any unauthorized

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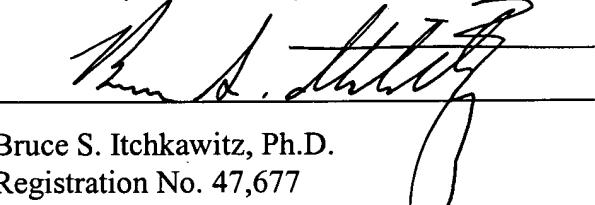
*ex parte* communications with Dr. Tunnell or other entities besides Applicant regarding the incomplete protest or any other aspects of the present application.

### **Conclusion**

In view of the foregoing, Applicant respectfully requests that the Examiner (i) withdraw the Notice and allow the appeal to proceed; (ii) confirm that the communication is not entered into the record of the present application; (iii) not consider the communication; (iv) withdraw the requirement for additional information from Applicant; and (v) send all the original protest papers to Applicant.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP



Bruce S. Itchkawitz, Ph.D.  
Registration No. 47,677  
Attorney of Record  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant	:	Bogdan C. Maglich	Group Art Unit 3663
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Examiner	:	Daniel L. Greene Jr.	

**DECLARATION OF BRUCE S. ITCHKAWITZ, PH.D.**

Dear Sir:

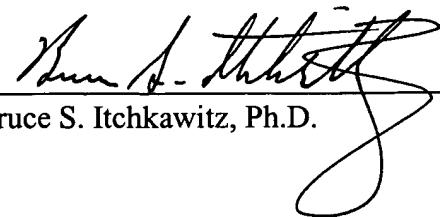
I, Bruce S. Itchkawitz, Ph.D., declare and state:

1. I am an attorney with Knobbe, Martens, Olson & Bear, LLP, which represents HiEnergy Technologies, Inc. with regard to its intellectual property matters.
2. I am the attorney of record for U.S. Patent Application No. 09/883,851 ("the '851 application"), which is assigned to HiEnergy Technologies, Inc.
3. I was first made aware of the existence of the "Statement Regarding Interactions with Bogdan Maglich" ("the communication") by a June 7, 2006 voicemail and a June 8, 2006 telephone conversation with Examiner Daniel L. Greene Jr.
4. I first saw a copy of the communication in the "Notice of Non-Compliant Appeal Brief" mailed by the USPTO on June 12, 2006 and received by my firm, Knobbe, Martens, Olson & Bear, LLP on June 15, 2006.
5. I have not been served with a copy of the communication by any other entities.
6. I am informed and believe that my firm, Knobbe, Martens, Olson & Bear, LLP has not been served with a copy of the communication by any other entities.
7. I am informed and believe that HiEnergy Technologies, Inc. has not consented, and continues to not consent, to the entry into the record of the '851 application of a protest based on the communication.

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8. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further declare that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated: 12/12/06

By:   
Bruce S. Itchkawitz, Ph.D.

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